

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-158 are currently pending in this application. Claims 1, 5, 32, 39, 51, 53-55, 62, 64, 68, 95, 102, and 116-118 are sought to be amended. New claims 129-158 are sought to be added. No new matter is believed to be added by these amendments, and their entry is respectfully requested.

Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Examiner Interview

Applicant's undersigned representative wishes to thank the Examiner for the productive Examiner Interview conducted on January 31, 2002.

Rejection under 35 U.S.C. § 101

In paragraph 2 of the Office Action, the Examiner has rejected claims 1 and 64 under 35 U.S.C. § 101. During the Examiner Interview, the Examiner explained that this rejection could be overcome by amending the claims to recite a device or machine. Without acquiescing to the propriety of this rejection, Applicant has accommodated this rejection by amending independent claims 1 and 64 to recite a data processing device(s). New independent claims 155 and 157

include similar recitations. Accordingly, Applicant asserts that this rejection has been overcome, and respectfully requests that it be withdrawn.

Information Disclosure Statement

In paragraph 3 of the Office Action, the Examiner has indicated that Reference AR7 was not considered because it was not included with the original IDS submission. Applicant herewith submits a copy of this reference via a Second Supplemental Information Disclosure Statement, and requests that it (as well as the other references cited therein) be considered.

Rejection Under 35 U.S.C. § 103

In paragraph 4 of the Office Action, the Examiner has rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,761,650 to Munsil *et al* in view of U.S. Patent No. 5,673,402 to Ryan. Applicant respectfully traverses the rejection.

As noted in the previously filed Reply, there are a number of differences between the claimed invention and Munsil. There are also differences between the invention and Ryan. However, for the following reasons, it is not deemed necessary to discuss these differences at this time (although Applicant reserves the right to do so in the future if the circumstances warrant).

Previously, Applicant filed a Declaration under 37 C.F.R. § 1.131 to "swear behind" the Munsil patent. In paragraph 6 of the Office Action, the Examiner stated: "The affidavit filed on 8/28/2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Munsil

reference.” The Examiner also stated: “In this case the applicant must show evidence of facts to establish diligence from 12/29/95-6/10/96.” (The Office Action said “12/2/95,” but it is believed that the correct date is 12/29/95, the filing date of Munsil.)

As a consequence of the Examiner’s position in the Office Action, Applicant conducted a supplemental search of his records to locate additional evidence supporting diligence from 12/29/95-6/10/96. Applicant did, indeed, locate additional evidence. In fact, based on such additional evidence, Applicant respectfully asserts that he *both* conceived of *and* reduced to practice the claimed invention prior to December 29, 1995, which is the effective date of Munsil. Conception and reduction to practice are discussed separately below.

Conception

37 C.F.R. 1.131(a) states:

When any claim of an application . . . is rejected, the inventor . . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference

37 C.F.R. 1.131(b) states:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Filed herewith is an amended Declaration under 37 C.F.R. § 1.131 by Richard Libman (referred to as the “Libman Declaration”), which includes Exhibits 1-9. These exhibits represent “Original exhibits of drawings or records, or photocopies thereof” as required by 37 C.F.R. 1.131(b).

The redacted dates of Exhibits 1-8 are prior to December 29, 1995, the effective filing date of Munsil. The date of Exhibit 9 is after December 29, 1995 (Exhibit 9 is dated January 22, 1996), but it describes activities that occurred prior to December 29, 1995 (as described below).

It is respectfully asserted that Exhibits 1-9 clearly support Applicant’s contention that the claimed invention was conceived prior to December 29, 1995. For example, the mapping between claim 1 and the Exhibits of the Libman Declaration is summarized in the following table.¹

| Claim 1 (as amended) | |
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| Claim Element | Documentation of Conception |
| A method of automatically preparing a communication pertaining to a financial product or a financial service for an entity, the method comprising: | Conception of this element is clearly documented by the top of Exhibit 1, which states “Automatic Process Financial Products/Service” and “each step automatic.” This is also documented by Exhibit 2, which is an example communication designed to be automatically prepared by the invention. |
| (1) automatically determining whether to offer a financial product or a financial service to said entity; | Conception of this element is clearly documented by Exhibits 4-6. These flowcharts include conditional statements for determining whether to |

¹ It is noted that such mapping is provided for illustrative purposes only. The claims are not limited by the example embodiments shown in the exhibits of the Libman Declaration, or by the remarks to those embodiments contained herein.

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| | offer an insurance product to a given customer based on the customer's age. This is also documented by Exhibit 7, which summarizes a computer run of the invention. (See paragraphs 6 and 7 of the Libman Declaration.) The summary of Exhibit 7 shows that offers were not made to particular customers ("NON-DM") based on a number of conditions, for example, the existence of a bad loan ("BAD LOAN"), rider ("BAD MODE: RIDERS"), age ("TOO YOUNG"), etc. |
| (2) if it is determined to offer a financial product or a financial service to said entity, | Conception of this element is clearly documented by Exhibit 7, which summarizes a computer run of the invention. (See paragraphs 6 and 7 of the Libman Declaration.) The summary of Exhibit 7 shows that offers were made to particular customers ("DM") if certain conditions were satisfied. These conditions related to the absence of a bad loan ("BAD LOAN"), rider ("BAD MODE: RIDERS"), age ("TOO YOUNG"), etc. |
| then using decision information | Conception of this element is clearly documented by the box "Inputs" in the flow diagram of Exhibit 1. "Rules" appears under that box, which is a type of the recited "decision information". Also, in the 3 rd bullet of Exhibit 1, there is written "artificial intelligence to replicate human thought process," which would involve some type of the recited "decision information." |
| to automatically determine variable information, the variable information for inclusion in the communication for said entity; and | Conception of this element is clearly documented by the second bullet of Exhibit 1, which states "put out a communication individualized (with product, service, format)." The communication would be individualized using, for example, variable |

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| | information. Conception is further documented by the boxes in page 1 of Exhibit 2, which show the use of variable information. |
| (3) automatically generating the communication, | Conception of this element is documented in the second bullet of Exhibit 1, which states "put out a communication individualized (with product, service, format)." |
| the communication including an offering to said entity for a financial product or a financial service, | Conception of this element is supported by Exhibit 2, which is a letter containing an offering for a financial product. Also see the heading of Exhibit 1. |
| the communication having a communication format, | Conception of this element is documented in the second bullet of Exhibit 1, which states "format" in the parenthetical. Also, Exhibit 2 represents a sample format, where variable information is inserted into the boxes (as well as other places) shown on page 1. |
| wherein said communication format comprises at least one portion that accommodates the variable information, | Conception of this recited element is documented by Exhibit 2 which represents a sample format, where variable information is inserted into the boxes shown on page 1. Such boxes include computer codes into which variable information is inserted. |
| the generating step including incorporating the variable information into said at least one portion of the communication, | Conception of this recited element is documented by Exhibit 2 which represents a sample format, where variable information is inserted into the boxes shown on page 1. |
| wherein the variable information is related to said offering, and wherein the variable information comprises at least one of financial product information, financial service information, offer information, and entity information; | Conception of this recited element is documented by Exhibit 2. For example, the variable information contained in the Policy A, B, and C boxes relates to the offer for insurance and comprises financial product information. |

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| wherein steps (1), (2), and (3) are performed using one or more data processing devices, and are performed within an automated process. | Conception of this recited element is documented by Exhibit 1. For example, the heading of Exhibit 1 is "Automatic Process financial products/service." The third bullet of Exhibit 1 states "Artificial intelligence to replicate human thought process and also automate each step." This is also documented by Exhibits 7 and 8, which summarize automated computer runs of the invention. (See paragraphs 6 and 7 of the Libman Declaration.) |
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Accordingly, Applicant respectfully asserts that the Libman Declaration and the attached Exhibits establish conception of the claimed invention prior to December 29, 1995. If the Examiner disagrees with Applicant's assertion, then Applicant respectfully requests that the Examiner note with particularity the alleged deficiencies with the Libman Declaration and/or the Exhibits attached thereto.

Reduction to Practice

It is respectfully asserted that Exhibits 1-9 clearly support Applicant's contention that the claimed invention was reduced to practice prior to December 29, 1995. In particular, prior to December 29, 1995, Applicant developed computer software to implement the claimed invention. See paragraph 4 of the Libman Declaration, where Applicant states:

Computer software to implement my invention was developed and operational prior to December 29, 1995. For example, software to

automatically generate communications like that shown in Exhibit 2 was developed and operational prior to December 29, 1995.

Also, in paragraph 5 of the Libman Declaration, Applicant states:

Also, Exhibits 4 – 6 are flowcharts of one application of my invention that document the operation of software that automatically generates offerings for different types of insurance products. Exhibit 3 is a listing of pseudo-code that generally corresponds to Exhibit 4. Computer software implementing the pseudo-code and flowcharts of Exhibits 3 – 6 (and/or similar pseudo-code / flowcharts) was operational prior to December 29, 1995.

Applicant further states that, prior to December 29, 1995, “the software . . . was used to automatically generate communications as described in the '434 Patent and the '086 Application.” Libman Declaration, paragraph 6. Exhibits 7 and 8 of the Libman Declaration document two runs of such software, where 248 direct marketing letters were generated in the first run (Exhibit 7), and 177 direct marketing letters were generated in the second run (Exhibit 8).

Exhibit 9 is an article “Agents’ Net Home Pages Begin To Generate Leads” dated January 22, 1996. This article described one of Applicant’s direct marketing campaigns, which took place prior to December 29, 1995. The article states: “Out of 1,700 solicitations in one of his firm’s direct marketing programs, 19 percent usually send applications, he said.” In

paragraph 9 of the Libman Declaration, Applicant states that this “direct marketing program took place prior to December 29, 1995.” Applicant also states that “this direct marketing program involved the generation of 1,700 communications,” which were “automatically generated in the manner described in the '434 Patent and the '086 Application, using the software discussed above (and/or related software).” Such generation by computer software was performed prior to December 29, 1995. It is noted that Mr. Libman was interviewed for this article prior to December 29, 1995. Accordingly, the article reports events that took place prior to December 29, 1995. This further supports Applicant’s contention that his invention was reduced to practice prior to December 29, 1995.

The Libman Declaration and the attached Exhibits clearly establish that the claimed invention was developed and operational prior to December 29, 1995. Accordingly, Applicant respectfully asserts that conception and reduction to practice of the claimed invention prior to December 29, 1995 have been established. If the Examiner disagrees with Applicant’s assertion, then Applicant respectfully requests that the Examiner note with particularity the alleged deficiencies with the Libman Declaration and/or the Exhibits attached thereto.

Summary

37 C.F.R. 1.131(b) requires the “showing of facts shall be such, *in character and weight*, as to establish reduction to practice prior to the effective date of the reference”

Applicant has supplied the Libman Declaration containing Exhibits 1-9. Exhibits 1-8 have redacted dates prior to December 29, 1995, and Exhibit 9 describes activities that took place prior to December 29, 1995 (the filing date of Munsil). Applicant asserts that such

documents are of sufficient *character and weight* to satisfy the requirements of 37 C.F.R. 1.131(b).

Accordingly, Applicant asserts that invention of the claimed subject matter prior to December 29, 1995 has been established, and that Munsil should be withdrawn as a reference against the claims. Ryan does not teach or suggest the claimed invention. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. § 103(a) based on Munsil and Ryan.

If the Examiner disagrees with Applicant's assertions, then Applicant respectfully requests that the Examiner note with particularity the alleged deficiencies with the Libman Declaration and/or the Exhibits attached thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,


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Version with markings to show changes made

Attorney Docket No.:

Change the Attorney Docket No. from “23651.0536” to –2176.0010002--.

In the Claims:

Claims 1, 5, 51, 53-55, 62, 64, 68, and 116-118 have been amended as follows:

1. (Twice Amended) A method of automatically preparing a communication pertaining to a financial product or a financial service for an entity, the method comprising:

(1) automatically determining whether to offer a financial product or a financial service to said entity;

(2) if it is determined to offer a financial product or a financial service to said entity, then using decision [criteria] information to automatically determine variable information, the variable information for inclusion in [a first variable portion of] the communication for said entity; and

[accessing a communication format for the communication wherein the communication format includes a second variable portion; and]

(3) automatically generating the communication [according to the communication format], the communication including an offering to said entity for a financial product or a financial service, the communication having a communication format, wherein said

communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into [the first variable portion of] said at least one portion of the communication [corresponding to the second variable portion of the communication format], wherein the variable information is related to said offering, and wherein the variable information comprises at least one of financial product information, financial service information, offer information, and entity information;

wherein steps (1), (2), and (3) are performed using one or more data processing devices, and are performed within an automated process.

5. (Amended) The method of claim 1, wherein said using step comprises:
applying said decision information to retrieve or select information [from a database], said retrieved or selected information to be included in said communication.

32. (Amended) The method of claim 1, further comprising:
selecting a subset of entities from a set of available entities; and
performing said determining, using, [accessing,] and generating steps for only said selected subset of entities.

39. (Amended) The method of claim 37, further comprising:
generating said communication format based on [financial products or financial services] said financial product or said financial service being offered to said entity.

51. (Amended) The method of claim 1, wherein said using step comprises:
(a) determining said variable information by performing one or more calculations [in accordance with said decision information].

53. (Amended) The method of claim 1, wherein said using step comprises:
[determining one or more types of financial products or financial services to offer to said entity; and]
determining [, for each of said types,] whether to offer one or more particular financial products or financial services [to offer] to said entity.

54. (Amended) The method of claim 53, wherein said using step further comprises:
calculating one or more amounts of said one or more particular financial products or financial services to offer to said entity.

55. (Amended) The method of claim 54, wherein said using step further comprises:
calculating costs of said one or more amounts of said one or more particular financial products or financial services to offer to said entity.

62. (Amended) The method of claim 1, wherein said financial product or financial service relates to life insurance, and wherein said using step comprises:
determining, based on at least one of demographics, age of said entity, income of said entity, and other data pertinent to said entity, one or more life insurance plans to offer to said entity.

64. (Amended) An apparatus of automatically preparing a communication pertaining to a financial product or a financial service for an entity, comprising:

means for automatically determining whether to offer a financial product or a financial service to said entity;

means for using decision [criteria] information to automatically determine variable information if it is determined to offer a financial product or a financial service to said entity, the variable information for inclusion in [a first variable portion of] the communication for said entity; and

[means for accessing a communication format for the communication wherein the communication format includes a second variable portion; and]

means for automatically generating the communication [according to the communication format], the communication including an offering to said entity for a financial product or a financial service, the communication having a communication format, wherein said communication format comprises at least one portion that accommodates the variable information, said generating means incorporating the variable information into [the first variable portion of] said at least one portion of the communication [corresponding to the second variable portion of the communication format], wherein the variable information is related to said offering, and wherein the variable information comprises at least one of financial product information, financial service information, offer information, and entity information;

wherein said determining means, said using means, and said generating means operate in one or more data processing devices within an automated process.

68. (Amended) The apparatus of claim 64, wherein said using means comprises:

means for applying said decision information to retrieve or select information [from a database], said retrieved or selected information to be included in said communication.

95. (Amended) The apparatus of claim 64, further comprising:
means for selecting a subset of entities from a set of available entities; and
wherein said determining means, using means, [accessing means,] and generating means
operate for only said selected subset of entities.
102. (Amended) The apparatus of claim 100, further comprising:
means for generating said communication format based on [financial products or
financial services] said financial product or said financial service being offered to said entity.
116. (Amended) The apparatus of claim 64, wherein said using means comprises:
[means for determining one or more types of financial products or financial
services to offer to said entity; and]
means for determining [, for each of said types,] whether to offer one or more
particular financial products or financial services [to offer] to said entity.
117. (Amended) The apparatus of claim 116, wherein said using means further
comprises:
means for calculating one or more amounts of said one or more particular
financial products or financial services to offer to said entity.
118. (Amended) The apparatus of claim 117, wherein said using means further
comprises:
means for calculating costs of said one or more amounts of said one or more
particular financial products or financial services to offer to said entity.

New claims 129-158 have been added.